Supreme Court, U.S.
FILED
OCT 25 2002
OFFICE OF THE CLERK

No. 02-289

IN THE

Supreme Court of the United States

R. BRENT JOHNSON, INTERFACE DESIGN GROUP, INC., AND SECUREAGENT.COM, INC. (FORMERLY KNOWN AS GLOBAL INTERFACE SOLUTIONS, INC.),

Petitioners,

v.

I/O CONCEPTS, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

Petitioner R. Brent Johnson is a co-inventor of U.S. Patent 5,689,637 (the '637 Patent), which is assigned to Petitioner Interface Design Group, Inc. The '637 Patent issued as a result of a series of patent applications, the earliest of which was filed with United States Patent and Trademark Office on May 1, 1992 (U.S. Patent Application No. 07/887,886; "the '886 Application"). In the context of a summary judgment motion brought by Respondent I/O Concepts, the Petitioners conceded invalidity of the '637 Patent unless the patent was entitled to the May 1, 1992 filing date of the '886 Application. The district court granted summary judgment holding that the '637 Patent was not entitled to the filing date of the '886 Application because the '886 Application did not "enable" a person of ordinary skill in the art to make and use the invention defined by the claims of the '637 Patent. The Federal Circuit affirmed.

The Petition raises the following issues:

1. Whether the Federal Circuit has decided an important question of federal law that has not been, but should be, settled by this Court, or has decided an important federal question in a way that conflicts with relevant decisions of this Court.

2. Whether the district court denied Petitioners a Seventh Amendment right to a jury trial on the issue of enablement.

STATEMENT PURSUANT TO RULE 29.6

Respondent, I/O Concepts, Inc., has no parent corporation, and no publicly-held company owns 10% or more of its stock.

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STATEMENT OF THE CASE

The District Court for the Western District of Washington accurately set forth the pertinent facts related to its granting of summary judgment. [Petition Appendix pp. 2a-15a]. Briefly stated, the Petitioners admitted that the invention claimed in the '637 Patent was offered for sale prior to April 13, 1992, and conceded that the '637 Patent would be invalid unless the '637 Patent was entitled to an effective filing date of May 1, 1992 (i.e., the filing date of U.S. Patent Application No. 07/887,886 ("the '886 Application")). The district court found that the claims of the '637 Patent were not enabled by the disclosure set forth in the '886 Application within the meaning of 35 U.S.C. § 112, first paragraph, which required that the '886 Application contain a "written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which is most nearly connected, to make and use the same. . . . " The Federal Circuit affirmed the district court grant of summary judgment, *per curium*, pursuant to Fed. Cir. R. 36 and Petitioners' motions for rehearing and rehearing *en banc* were denied [Petition Appendix 1a].

I. CLARIFICATION OF RECORD

The Petitioners' contention that the district court and the Federal Circuit unjustifiably denied the Petitioners the right to trial by jury on the issue of enablement is new argument that was not presented to the district court in a motion for reconsideration or to the Federal Circuit either on appeal or in seeking rehearing and rehearing *en banc*. When Petitioners sought summary judgment, they never argued entitlement to

a jury trial on any issue that was before the district court. Instead, the Petitioners conceded that the issue of enablement under 35 U.S.C. § 112, ¶1 presents a question of law. [Petition Appendix p. 6a].

Having lost their case at the district court and appellate levels, the Petitioners now argue for the first time that, "[s]ubstantial evidence was introduced which was worthy of review by a jury." [Petition p. 5]. According to the Petitioners, "Respondent's definition of an individual skilled in the art of the invention and its assertions that such an individual would not be able to practice the invention based on the '886 disclosure, are factual issues which were vigorously contested by Petitioners. [citing Petition Appendix, 17a, 21a, 23a-24a]." That is untrue to the extent that neither the district court nor the Federal Circuit was presented with an issue relating to the "definition of an individual skilled in the art" that would have presented a jury question. The only issue before the district court that related in any way to "skill in the art" was an evidentiary issue which arose because the Petitioners argued that Respondent's technical expert lacked the requisite expertise to be considered one of ordinary skill in the art. [Petition Appendix pp. 9a-11a].

The two statements of Petitioners' technical expert, Arthur Zatarain, that are only partially included in the Petition [Petition Appendix pp. 17a-33a] do not support Petitioners' contention that a jury determination was needed relative to the "definition of an individual skilled in the art of the invention." All of Mr. Zatarain's statements relating to "skill in the art" were what the district court referred to as "remarks impugning the claimed expertise of Mr. Thompson [Respondent's technical expert]." *See*, for example,

Mr. Zatarain's statement that a statement by Respondent's expert "only makes sense for someone ***unfamiliar with computer displays and mainframe operating systems***." [Petition Appendix 19a]; "Any suggestion that this [statement made by Respondent's technical expert] is inadequate and could only come from someone under ***very*** unskilled in the pertinent art [Petition Appendix p. 20a]; and Respondent's technical expert "doesn't understand the invention." [Petition Appendix p. 23a] (Emphasis in the noted declarations).

Admissibility of expert opinion or testimony based on scientific, technical or other specialized knowledge is governed by Rule 702 of the Federal Rules of Evidence. Any issue as to the admissibility of expert testimony is resolved by the court not a jury. In this case, the only issue relating to the "definition of an individual skilled in the art of the invention" [Petition p. 5] was that Respondent's expert, Mr. Thompson, lacked the requisite expertise to be "an individual skilled in the art of the invention," which the district court considered and rejected [Petition Appendix pp. 9a-11a].[1]

There are other "facts" recited in the Petition that bear little resemblance to the record facts below. For example, the Petition states that "the district court gave little weight to Petitioners' evidence." [Petition p. 5; citing Petition Appendix pp. 9a, 10a and 11a]. In each instance referenced by Petitioners, the district court stated "this ***argument*** carries little weight." Argument is not evidence.

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1. Petitioners are well aware of the fact that their only "skill in the art" argument before the Federal Circuit continued to be that Respondent's expert lacked experience sufficient to satisfy Rule 702 of the Federal Rules of Evidence.

Additionally, the Petition notes that trial of this case was to be "trial by jury as to all issues triable by a jury, which would include questions of validity and infringement." It is true that the case was subject to a jury demand. However, the statement that questions of validity and infringement would go to the jury is an overly broad, incorrect statement of law.[2]

REASONS FOR DENYING THE PETITION

I. THE PETITIONERS HAVE NOT ARTICULATED A COMPELLING REASON TO JUSTIFY DISCRETIONARY REVIEW BY THIS COURT

"Review on a Writ of Certiorari is not a matter of right, but of judicial discretion." Sup. Ct. R. 10. "A petition for a Writ of Certiorari will be granted only for compelling reasons." *Id.* The Petitioners have not presented any compelling reason for this Court to exercise discretionary jurisdiction over the district court grant of summary judgment.

It is well settled that "ordinarily this Court does not decide questions not raised or resolved in the lower court[s]." *Taylor v. Freeland & Kronz*, 503 U.S. 638, 646 (1992); *Youakim v. Miller*, 425 U.S. 231, 234 (1976), *per curium* (same); *see Pennsylvania Dept. of Corrections v. Yeskey*, 524 U.S. 206, 212 (1998) ("where issues are neither raised before nor considered by the Court of Appeals, this Court will not ordinarily consider them."); *Holly Farms Corp. v. Nat'l Labor Relations Bd.*, 517 392, 400 n.7 (1996)

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2. For example, the question of validity in the context of an "on-sale defense, is a question of law." *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55 (1998).

("we 'generally do not address arguments that were not the basis for the decision below.' ") (citations omitted); *Duignan v. United States*, 274 U.S. 195, 200 (1927) ("It is only in exceptional cases coming here from the federal courts that questions not pressed or passed upon below are reviewed." *Cardinale v. Louisianna*, 394 U.S. 437, 439 (1969) ("Questions not raised below are those on which the record is very likely to be inadequate, since it certainly was not compiled with those questions in mind.") *Microsoft Corp. v. United States*, 530 U.S. 1301 (2000) ("A court of appeals proceeding would likely narrow, focus, and initially decide the legal issues now presented here.") (Breyer, J., dissenting from denial of direct appeal).

The issue raised in the Petition — the right to jury trial on the question of enablement under 35 U.S.C. § 112 — was not before the district court when it considered and granted summary judgment in favor of Respondent. In fact, Petitioners conceded that the issue of enablement presented a question of law rather than a question of fact. [Petition Appendix p. 6a]. Petitioners do not (and can not) contend that the Federal Circuit was presented with the jury trial issue.

This case simply is the wrong vehicle to address any perceived conflict between the Federal Circuit's standard of review on enablement issues and the Seventh Amendment. In this case, the district court granted summary judgment and the Federal Circuit affirmed. Affirmance was so clear that it was *per curium*, without any written opinion. As discussed below, summary judgment was proper and would have been the result regardless of whether enablement under 35 U.S.C. § 112 is a question of law or fact. If the need exists to resolve the Petitioners' perceived conflict, it should be brought to this Court under far different facts and circumstances than this case presents.

II. A PROPERLY GRANTED SUMMARY JUDGMENT DOES NOT VIOLATE THE SEVENTH AMENDMENT EVEN THOUGH THE CLAIM ON WHICH SUMMARY JUDGMENT IS GRANTED INVOLVES QUESTIONS OF FACT

In *Anderson v. Liberty Lobby*, 477 U.S. 242 (1986), this Court reversed a District of Columbia Circuit decision that had reversed portions of a trial court grant of summary judgment to the defendants in a defamation case. In doing so, the Court held that the standard for granting summary judgment "mirrors" that for determining directed verdict motions under Rule 50 of the Federal Rules of Civil Procedure, and that "the trial judge must direct a verdict if, under the governing law, there can be but one reasonable conclusion as to the verdict." 477 U.S. at 250.[3]

In view of this Court's decision in *Liberty Lobby*, there can be no compelling argument that properly granted summary judgment conflicts with the Seventh Amendment right to jury trial. In *Liberty Lobby*, this Court equated the standard of summary judgment with the standard for judgment as a matter of law. In *Galloway v. United States*, 319 U.S. 372 (1943) this Court held that judgment as a matter of law (then referred to as a directed verdict) does not violate the Seventh Amendment right to a jury trial. 319 U.S. at 389-390. Later in *Neely v. Martin Eby Construction Co.*, (1967), this Court further held that judgment notwithstanding the verdict (now referred to as judgment as a matter of law) does not violate a party's right to jury trial. 386 U.S. 317, 321-322 (1967).

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3. A directed verdict has been renamed "judgment as a matter of law"; 1991 Amendments to Rule 50.

As discussed below, this case does not give rise to a Seventh Amendment issue because the district court properly granted summary judgment and the Federal Circuit affirmed *per curium*.

III. SUMMARY JUDGMENT WAS PROPERLY GRANTED IN THIS CASE

Rule 56(c) provides that summary judgment "shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue of material fact and that the moving party is entitled to judgment as a matter of law." Under Rule 56(e), to withstand a properly made summary judgment motion, the adverse party must set forth specific facts showing that there is a genuine issue for trial, which this Court has held to require substantial evidence, i.e., evidence sufficient to withstand a motion for directed verdict (judgment as a matter of law) and being capable of supporting a jury verdict in favor of the non-moving party. *Liberty Lobby*, 477 U.S. 242, 248-250. Where, as here, a non-moving party offers insufficient evidence to meet its burden, the court may grant summary judgment without offending the Seventh Amendment, just as it may grant judgment as a matter of law without offending the Seventh Amendment. The constitutional inquiry relative to summary judgment and judgment as a matter of law is identical, the primary differences being the timing and the nature of the proofs.

Liberty Lobby makes it clear that "the mere existence of ***some*** alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no ***genuine*** issue

of ***material*** fact." 477 U.S. 242, 247-248 (emphasis in original). The proper inquiry is "whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law." *Id.* at 252.

In its summary judgment analysis, the district court properly set forth the test of enablement pursuant to 35 U.S.C. § 112 as presenting the question of "whether one reasonably skilled in the art could make or use the invention from the disclosures in the description contained in the application, coupled with information known in the art." (Petition Appendix p. 6a; citations omitted). Further, the district court correctly stated that enablement under 35 U.S.C. § 112 "calls upon the inventor to describe ***how*** to make the invention without undue experimentation," [Petition Appendix p. 12a, citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988); *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988); emphasis in district court summary judgment order)].

After reviewing the evidence submitted by Petitioners to avoid summary judgment, the district court specifically held that Petitioners had failed to come forth with sufficient evidence as to enablement of two of the six steps contained in Method Claim 1 of the '637 Patent: the "scanning, recognizing and intercepting" step and what the district court referred to as the "performance" step.

With respect to the "scanning, recognizing and intercepting" step, the district court found that Petitioners' evidence of enablement consisted of its expert's statement that a programming language mentioned in the '886 Application

and known as "REXX" could be used as a "tool" to accomplish the "scanning, recognizing and intercepting step." The district court appropriately held that "merely pointing to a programming language does not tell one, even one of ordinary skill in the art, ***how to make*** the invention; it merely tells one what tools (i.e., what programming language) to use to make the invention" and, accordingly, that Petitioners had provided no testimony that "one skilled in the art would know how to use the REXX language to effect the step claimed in the '637 Patent." [Petition Appendix p. 12a; (emphasis in district court opinion)].[4]

The district court also specifically found that Petitioners had failed to come forth with sufficient evidence to support their contention that the May 1, 1992 application (the '886 Application) enabled the "performance" or "performing" step of Claim 1 of the '637 Patent.[5] In reaching its conclusion of insufficient evidence, the district court noted that the Petitioners' only evidence of enablement was a statement by their expert that the REXX programming language ***can*** perform the required automation (performance of at least one step that would normally have to be performed by

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4. Through apparent clerical error the "scanning, recognizing and intercepting" step of Claim 1 of the '637 Patent was omitted from the copy of Claim 1 that is set forth in the district court opinion. [Petition Appendix pp. 7a-8a]. The "scanning . . . " step is intermediate to the steps of Claim 1 that begin with "transferring" and "performing." In its entirety that step reads: "scanning, recognizing and intercepting said mainframe operator messages destined for a human operator."

5. Read in its entirety, the "performing" step of Claim 1 of the '637 Patent is "performing at least one step that would normally have to be performed by said human operator." [Petition Appendix p. 8a].

a human operator). Responding to that scant evidence, the district court stated

> asserting that an invention ***can*** perform a step is not the same as ***showing how*** the invention will perform the step, which is what must be shown to meet the enablement condition, therefore, this step is not enabled by the May 1, 1992 application [the '886 application] . . . defendants [petitioners] have produced no evidence to suggest that the performance step of the '637 Claim 1 is enabled by the May 1, 1992 application ['the 886 application].

[Petition Appendix p. 13a; (emphasis in district court order).]

No genuine issue of material fact exists to preclude summary judgment if the non-moving party has failed to establish each essential element of the required standard of persuasion. Failure to sufficiently support all necessary elements to the extent required by the burden to persuasion will render all the other facts immaterial. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). Additionally, Rule 56 of the Federal Rules of Civil Procedure requires that a court grant a motion for summary judgment if adequate time for discovery has passed and if the non-moving claimant has failed to establish each element of its case. *Celotex*, 477 U.S. at 325. Moreover, once the party moving for summary judgment has sustained the initial burden of production, the burden shifts to the non-moving party to show the court that there is, in fact, a genuine issue for trial. *Liberty Lobby*, 477 U.S. at 250. In this case, Respondent had the burden of showing lack of enablement by clear and convincing evidence. The Petitioners never contended that Respondent had not presented evidence sufficient to shift the burden of

going forward to Petitioners. As described above, Petitioners simply failed to meet their burden of showing the existence of genuine issues of material fact that would prevent the granting of summary judgment.

Now, in seeking a Writ of Certiorari, the Petitioners contend that factual issues exist as to the "definition of an individual skilled in the art." [Petition p. 5]. As discussed in Respondent's previously set forth "Clarification of the Record," the only issue as to "skill in the art" presented by Petitioners at both the trial court and appellate court level related to Petitioners attacking the qualifications of Respondent's technical expert, Mr. Thompson. Issues relating to the qualifications of an expert are evidentiary in nature (Federal Rules of Evidence, Rule 702). Those issues are not issues that are submitted to a jury. It is the trial judge who is assigned the task of resolving any such issues. *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579, 592 (1993); *General Elec. Co. v. Joiner*, 522 U.S. 136, 142 (1997); *Kumho Tire Co., Ltd. v. Carmichael*, 526 U.S. 137, 149 (1999). As this Court held in *General Elec. Co. v. Joiner*, district court judges have broad discretion in deciding whether to admit or exclude expert testimony pursuant to Rule 702. 522 U.S. at 141-142. Here, the district court took into consideration what it characterized as the Petitioners' "remarks impugning the claimed expertise of [Respondent's expert] Mr. Thompson" and concluded that the Petitioners had not "produced evidence sufficient to show that Mr. Thompson is not one of ordinary skill in the relevant art." [Petition Appendix pp. 9a-11a].

The remaining jury issue contentions set forth in the Petition are of no greater merit than the Petitioners' "skill in the art" contention. The district court reviewed both of the

expert statements that Petitioners rely upon in contending that issues existed that should have gone to a jury [the experts' statements are only partially set forth in the Petition Appendix at pp. 17a-33a]. After doing so, the district court held that Petitioners failed to meet their burden of showing the existence of an issue of material fact.

Summary judgment was properly granted in this case and the Petitioners' attempt to characterize the case as one that deprived the Petitioners' of a Seventh Amendment right to a jury trial has no merit.

IV. A SEVENTH AMENDMENT RIGHT TO JURY TRIAL ON THE ISSUE OF ENABLEMENT WOULD NOT AFFECT THE AVAILABILITY OF SUMMARY JUDGMENT PROCEEDINGS OR AFFECT THE OUTCOME OF THIS CASE

As is discussed in Section II., above, summary judgment does not violate the Seventh Amendment right to a jury trial in view of this Court's holding in *Liberty Lobby* and earlier cases specifically holding that comparable procedures available to the courts do not in conflict with the Seventh Amendment. If it is assumed that a party is entitled to a Seventh Amendment guarantee to a jury trial relative to the enablement provision of 35 U.S.C. § 112, summary judgment proceedings would still be available. Even under eighteenth century English law, judges had the authority to take patent enablement issues away from a jury. For example, in *Horton v. Harvey*, 490 $nb_4$8 (Middlesex 16 July 1781), the plaintiff was nonsuited because, as Lord Mansfield noted, "that improvement [what was considered to be the invention is] not in the specification." Similarly, in *Yerbury v. Wallace*, reported in the *London Evening Post*, (July 18, 1770),

the plaintiff, holder of a patent on a loom for wool, was nonsuited because the true nature of his invention was not given in his "description" of it "pursuant to his patent."[6] "Nonsuit" under eighteenth century English law clearly took a matter from the jury. That being the case, under this Court's precedence of *Liberty Lobby*, *Galloway* and *Neely*, the issue of enablement under 35 U.S.C. § 112 could be properly raised by summary judgment even if a Seventh Amendment right to jury trial existed on the enablement issue.

CONCLUSION

The Petition should be denied.

Respectfully submitted,

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6. *Horton* and *Yerbury* are discussed in Studies in Legal History, "The Mansfield Manuscripts and Growth of English Law in the Eighteenth Century," University of North Carolina Press, 1992 at page 733 with the *Horton* case being fully set forth at pp. 762.